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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------------|---------------------|------------------|
| 10/585,345 | 07/06/2006 | Joseba Txomin Osoro Loyola | | 2698 |

7590 03/02/2010
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| EXAMINER |
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NILFOROUSH, MOHAMMAD A

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| ART UNIT | PAPER NUMBER |
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3685

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| MAIL DATE | DELIVERY MODE |
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03/02/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/585,345

Applicant(s)OSORO LOYOLA, JOSEBA
TXOMIN**Examiner**

Mohammad A. Nilforoush

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-4 are pending.
2. Claims 1-4 have been examined.
3. This Office action is given Paper No. 20100220 for reference purposes only.

Examiner's Comments

4. Applicant's claims employ language that does not serve to differentiate the claims from the prior art.
5. Claim 1 recites "...an antenna (6) for communication with specific terminals...", "...readable by any CD/DVD reader available in the market..." and "...because it applies to the public and private transportation systems for use authorization and payment by the specific terminals capable of communicating with the digital card (1)." However, these limitations only recite the intended use or field of use of the claimed invention. Additionally, claim 3 recites that the microcomputer from the card and a cryptographic module microcomputer "...put into practice proven solutions like card-terminal mutual authentication, transaction certification, DES algorithms, which permit to recharge the digital card (1) at a distance under complete secure conditions and because mutual authentication in between at least a microcomputer (2) and the cryptographic module microcomputer from said specific terminals guarantees a safe decentralize structure for which is unnecessary to systematically obtain a central server authorization." However, this limitation also recites only the intended use of the claimed invention. Recitations of

intended use do not serve to differentiate the claims from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

6. Claim 2 recites "...*containing data related to said transportation systems readable with any commercial reader which facilitates its use by a card carrier.*"

However, this only describes the data stored on the card. As the stored data does not affect the structure of the claimed apparatus, it is nonfunctional descriptive material and does not serve to differentiate the claims from the prior art. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

7. Claim 4 recites "...other safety devices *may be added* such as..." However, as this does not require any structural limitations to be included in the claimed invention, but only recites that other features *may be added*, it is optional language. Optional language does not serve to differentiate the claims from the prior art. MPEP §2106 II C states that language that suggests or makes optional but does not require steps to be

performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Claim Objections

8. Claims 1-3 are objected to because of the following informalities: The claims recite the term "contactless" which appears to be a misspelling of the term "contactless" or "contact-less". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

12. Claims 1-4 make reference to multiple statutory classes of invention. Claims 1-4 are directed to "A CD/DVD digital card". However, claim 1 recites the method step of "communicating with the digital card", and claim 4 recites the step of "obtaining an identity card or passport having access control and cash payment capability by a security transfer." A claim that purports to be within multiple statutory classes is ambiguous and is properly rejected under U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claims 2-4 are also rejected as each depends on claim 1.

13. The terms "generally" and "similar shape" in claim 1 are relative terms which render the claim indefinite. The terms "generally" and "similar shape" Are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The use of these terms renders the shape of the CD/DVD digital card ambiguous.

Claims 2-4 are also rejected as each depends on claim 1.

14. Claim 1 further recites "...formed by a contact and contact-less chip..." It is unclear to one of ordinary skill whether this limitation refers to two separate chips, i.e. one contact chip and one contact-less chip, or whether this limitation refers to a single chip with contact and contact-less capabilities.

Claims 2-4 are also rejected as each depends on claim 1.

15. Claim 4 recites "...other safety devices may be added *such as...*" It is unclear to one of ordinary skill what structural elements are being claimed in claim 4 as the claim appears to only provide examples of hypothetical features the card may have, but does not positively recite that the card has any of these structural elements.

16. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutsche (US Patent No. 6,542,444) in view of Kamise, et al. (US Patent Application No. 2002/0064074, hereinafter "Kamise").

19. Regarding claim 1, Rutsche discloses a CD/DVD digital card with a contact-less microcomputer chip (1) characterized by a base (4), generally having a credit card or similar shape (Rutsche 3:14-18; 9:10-12), incorporating at least a microcomputer (2) formed by a contact and contact-less chip (5) in accordance with ISO standards and by an antenna (6) for communication with specific terminals (Rutsche 1:37-39, 1:55-2:3; 2:23-24; 3:26-30, 54-57; 6:49-50; 7:8-12, 7:40-8:19); a CD or DVD (3) readable by any

CD/DVD reader available in the market (Rutsche 1:34-37, 50-55; 2:16-24; 3:48-54; 6:1-48) and because it applies to systems for use authorization and payment by the specific terminals capable of communicating with the digital card (1) (Rutsche 9:22-24; 2:32-40).

Rutsche does not specifically disclose that the contact and contact-less chip is in accordance with the ISO 7616 standard specifically, and that the systems that the card is used with are public and private transportation systems.

Examiner takes Official notice that the constructing smartcards in accordance with the ISO 7616 standard is old and well-known.

Kamise discloses a smart card used with public and private transportation systems (Paragraphs 280-281).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the card of Rutsche to comply with the ISO 7616 standard specifically, in order to increase the versatility of the card by making it easier to adopt by vendors. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the card of Rutsche to use in public and private transportation systems as disclosed in Kamise in order to allow a single card to be used for multiple services, including transportation (Kamise Paragraph 14).

20. Regarding claim 3, Kamise discloses that at least one microcomputer (2) from the digital card (1) and a cryptographic module microcomputer from said specific terminal put into practice proven solutions like card-terminal mutual authentication, transaction certification, DES algorithms, which permit to recharge the digital card (1) at a distance under complete secure conditions and because mutual authentication in

between at least a microcomputer (2) and the cryptographic module microcomputer from said specific terminals guarantees a safe decentralize structure for which is unnecessary to systematically obtain a central server authorization (Kamise Figures **13-15**; Paragraphs **115, 153-167; 188-220**).

21. Regarding claim 4, Rutsche discloses that to this base (4) other safety devices may be added such as, magnetic strip, bar codes, Wiegand, scratchers, fingerprint digitalization, iris profile recording and information encrypting systems, obtaining an identity card or passport having access control and cash payment capability by a security transfer (Rutsche **2:40-42; 3:23-25; 4:43-47; 9:26-50, 64-67; 10:5-9**).

22. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rutsche in view of Kamise as applied to claim 1 above, and further in view of Nagatomo, et al. (US Patent Application Publication No. 2001/0054134, hereinafter "Nagatomo").

23. Regarding claim 2, Rutsche in view of Kamise does not specifically disclose that the CD or DVD (3) has a capacity value between 30 and 100 Mb and preferably between 30 and 50 Mb and containing data related to said transportation systems readable with any commercial reader which facilitates its use by a card carrier.

Nagatomo disclose that the CD or DVD (3) has a capacity value between 30 and 100 Mb and preferably between 30 and 50 Mb and containing data related to said transportation systems readable with any commercial reader which facilitates its use by a card carrier (Nagatomo Abstract, Paragraphs **65-73; 89, 108-123, 167, 198, 216**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the card of Rutsche in view of Kamise so the CD or DVD has a capacity between 30 and 50 Mb and contains data related to transportations systems as disclosed in Nagatomo in order to allow the card to be used in a navigation device (Nagatomo Paragraphs **27, 108, 113-118**).

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent Application Publication No. 2004/0034784 to Fedronic, et al. for disclosing ISO-7616 compliant smart cards (Paragraph **2**).

25. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning
facsimile transmissions and mailing, respectively.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Nilforoush whose telephone number is (571)270-5298. The examiner can normally be reached on Monday-Thursday 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. N./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

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It appears that the applicant in this application is a *pro se* applicant (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the preferred methods of ensuring timely filing of responses to communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

CERTIFICATE OF MAILING

To ensure that the Applicant's mailed response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page (preferably on the first page) of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on (date).

(Typed or printed name of the person signing this certificate)

(signature)

CERTIFICATE OF TRANSMISSION

Alternatively, if applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They must be signed, and the date must be the actual date on which it is mailed or transmitted.

For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

NOTICE TO APPLICANT: In the case of lost or late responses the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or a private shipper such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are not

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considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.